

**U.S. Pat. Appl. Ser. No. 10/517,743
Attorney Docket No. 10191/3824
Reply to Final Office Action of June 9, 2009**

REMARKS

Claims 15 to 19 and 21 to 29 are currently pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

With respect to the Information Disclosure Statement (IDS) of August 14, 2008, the Office Action asserts that the IDS fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each listed publication or that portion which caused it to be listed. As an initial matter, the International Search Authority should have forwarded copies of the cited publications since they were each referenced in the International Search Report for International Patent Application No. PCT/DE03/01771, of which the present application is a national phase.

Moreover, even if the documents were not received by the United States Patent and Trademark Office (USPTO), on August 14, 2008, Applicants submitted copies of each of the cited publications together with the filing of the Information Disclosure Statement of August 14, 2008, as is readily apparent on the USPTO's Patent Application Information (PAIR) system, which includes copies of each of the references in the Image File Wrapper (IFW) tab. Specifically, with respect to the first and third documents cited under "Other Documents," which the Office Action asserts are missing, the first document, "Final Text for Dis 11172-1 (rev. 2) . . .," is the 58 page NPL Document posted in the IFW tab (the top-right corner of that document states "1-11172 rev 2"), and the third document is the first 9 pages of the 18 page NPL Documents posted in the IFW tab.

The Office Action further asserts that the IDS fails to comply with 37 CFR 1.98(a)(3)(ii), which requires a copy of a translation of a non-English language document. Specifically, the Office Action requires a translation for each of the last two documents cited under "Other Documents." However, 37 CFR 1.98(a)(3)(ii) requires a copy of a translation of a non-English language document only if such a translation is within the possession, custody, or control of, or is readily available to any individual designated in section 1.56(c). Since translations of the two referenced documents are not within the possession, custody, or control of, and are not readily available to, any individual designated in section 1.56(c), therefore filing of the translations is not required. Moreover, it is noted that a concise explanation of the relevance of each of the referenced documents has been submitted. In this regard, as is apparent from the PAIR system, a copy of the International Search Report ("the Search Report") issued in International Patent Application No. PCT/DE03/01771 was

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received by the USPTO on December 9, 2004. The Search Report notes that each of the first and second referenced documents, “The MPEG 2 Standard Multiplex . . .” and “The MPEG 2 Standard Generic . . .” is an ‘A’ type reference pertinent to claims 1, 6, 7, 11. See the final listing at “Seite 2 von 3” and the listing at “Seite 3 von 3” of the Search Report.

Accordingly, the IDS of August 14, 2008 complies with 37 CFR 1.98 and should be considered. It is therefore respectfully requested that the cited references be considered and made of record.

Claims 15 to 19, 27, and 28 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 6,674,805 (the “Kovacevic” reference) in view of U.S. Patent Application Publication No. 2002/0052975 (the “Yamamoto” reference), in further view of U.S. Patent No. 6,816,491 (the “Fuji” reference).

To reject a claim as obvious under 35 U.S.C. § 103, the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied.

First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). As clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1741.

Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986).

Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As explained herein, the Final Office Action does satisfy these requirements as to all of the features of the claims.

Claim 28 relates to a method for generating a counter in a receiving device for digital data streams, and provides for “generating the digital data streams in a transmitting

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device by sampling analog signals at a sampling frequency synchronized by a system time clock in the transmitting device.” The “Kovacevic” reference does not disclose or suggest this feature. Indeed, the Final Office Action concedes this defect but relies on the Yamamoto reference to cure this critical deficiency. However, as noted above, in order to sustain an obviousness rejection, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR, supra.* In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with **some rational underpinning** to support the legal conclusion of obviousness.” *Id.*, at 1741. In contrast to the Supreme Court’s stated guidelines, the Final Office Action clearly has not provided any “articulated reasoning with **some rational underpinning** to support the legal conclusion of obviousness; instead the Final Office Action is relying on “mere conclusory statements.” In this regard, simply asserting by the Final Office Action that it “would have been obvious to one of ordinary skill in the art . . . to modify Kovacevic as suggested by Yamamoto in order to perform the encoding process according to MPEG standards” (*Final Office Action*, page 3) does not provide articulated reasoning with some rational underpinning as to why one skilled in the art would combine the reference as suggested. For example, the “Kovacevic” reference pertains to a **digital system** which processes **compressed digital data**. (*See*, Kovacevic, column 4, lines 34 to 43.) The MPEG standard does not provide that the signal should be in analog form to begin with. That the “Yamamoto” reference refers to an analog video signal has absolutely nothing to do with the MPEG standard. Indeed, the “Kovacevic” reference itself pertains to an MPEG 2 decoder and does not provide for sampling analog signals. Therefore, the Final Office Action has not provided any reasoning for modifying the first reference to include any such conversion. Indeed, there would be no gain or benefit in modifying the system of the “Kovacevic” reference to include element 22 of the “Yamamoto” reference because there simply **are no analog signals in the “Kovacevic” reference to convert to digital.**

Further, the cases of *In re Fine, supra*, and *In re Jones*, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action’s generalized assertions that it would have been obvious to modify or combine the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper

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evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of *In re Fine* stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fine, at 1598-1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of *In re Jones* stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].

In re Jones, 2 1943-44 (citations omitted; italics in original).

The present Office Action offers no evidence, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

Still further, claim 28 provides for “**determining the sampling frequency of one of the data streams** in the receiving device.” The Final Office Action concedes that “Kovacevic and Yamamoto do not expressly disclose determining the sampling frequency of one of the data.” (*Final Office Action*, page 3.) However, the Final Office Action relies on

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the “Fujii” reference to cure this critical deficiency. It is respectfully submitted that the “Fujii” reference is not proper prior art for at least the following reasons.

The “Fujii” reference does not determine the sampling frequency of the data stream but is provided this information in the header information. Indeed, the Final Office Action concedes that “Fujii . . . discloses that the header information include[s] a sampling frequency, a bit rate and etc....” (*Final Office Action*, page 4). Accordingly, the “Fujii” reference does not disclose or suggest the feature of determining the sampling frequency of one of the data streams in the receiving device” as provided in the context of claim 28.

For all of the foregoing reasons, the combination of the “Kovacevic,” “Yamamoto,” and “Fuji” references does not disclose or suggest all of the features of claim 28, so that the combination of the “Kovacevic,” “Yamamoto,” and “Fuji” references does not render unpatentable claim 28 or any of its dependent claims, e.g., claims 15 to 19 and 27.

Withdrawal of this obviousness rejection of claims 15 to 19, 27, and 28 is therefore respectfully requested.

Claims 21 to 26 and 29 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of U.S. Patent No. 6,363,207 (the “Duruoz” reference), the “Kovacevic” reference, the “Fuji” reference, the “Yamamoto” reference, and U.S. Patent No. 6,988,238 (the “Kovacevic-2” reference).

Claim 29 relates to a receiving device and provides for “a unit for correctly determining a sampling frequency of one of the packetized elementary data streams.” The Final Office Action asserts that the “Kovacevic” reference discloses the above feature. In support of this assertion, the Office Action refers to column 2, lines 27 to 32 of the “Kovacevic” reference, which states that “[t]he time base of the STC and the encoder system is appropriately 27 MHz. To prevent overflow or underflow of received compressed bit stream buffers, the STC counter associated with the MPEG-2 decoder has to be synchronized to the 27 MHz time base of the system encoder with an accuracy of 1 Hertz.” It is respectfully submitted that the cited section does not support the Final Office Action’s contention. Nothing in the cited section, nor any other section of the entire “Kovacevic” reference, suggests that there is a determining a sampling frequency, let alone of one of the packetized elementary data streams. Indeed, the cited section discloses that a certain frequency (i.e., 27MHz) is not determined but assumed. At best, the “Kovacevic” reference merely tweaks the frequency to within 1% accuracy. A “unit for correctly determining a

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sampling frequency of one of the packetized elementary data streams” as provided in claim 29 is not disclosed or suggested.

Further, the mere mentioning of a certain frequency (i.e., 27 MHz) does not suggest a **sampling** frequency but merely a **clocking** frequency. Thus, the interpretation that 27 MHz is a sampling frequency is unsupported, particularly in light of the fact that the “Kovacevic” reference is replete with dividers, which can substantially modify internal frequencies. The secondary references does not cure, and are not asserted to cure, these critical deficiencies.

Accordingly, the combination of the “Duruoz,” “Yamamoto,” “Kovacevic,” “Fuji,” and “Kovacevic-2” references does not disclose or suggest all of the features of claim 29, so that the combination of the “Duruoz,” “Kovacevic,” “Fuji,” and “Kovacevic-2” references does not render unpatentable claim 29 or any of its dependent claims 21 to 26.

As further regards claim 21, it provides that “the synchronization unit sets an increment of the counter, the increment being determined from a ratio between a program clock reference and a nominal sampling frequency.” The Final Office Action asserts that the “Kovacevic” reference discloses the above feature. However, as explained above, the “Kovacevic” reference does not disclose or suggest synchronizing the counter according to the sampling frequency. Further, there is no discussion in the “Kovacevic” reference of the increment of the counter being determined from **a ratio between a program clock reference and a nominal sampling frequency** as provided in the context of claim 21. The “Fuji,” “Yamamoto,” and the “Kovacevic-2” references do not cure, and are not asserted to cure, this critical deficiency of the “Duruoz” and “Kovacevic” references. For this additional reason, the combination of the “Duruoz,” “Kovacevic,” “Fuji,” and “Kovacevic-2” references does not disclose or suggest all the features of claim 21, so that the combination of the “Duruoz,” “Kovacevic,” “Fuji,” and “Kovacevic-2” references does not render unpatentable claim 21 for this additional reason.

Withdrawal of this obviousness rejection of claims 21 to 26 and 29 is therefore respectfully requested.

Accordingly, all of pending claims 15 to 19 and 21 to 29 are in condition for immediate allowance.

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Conclusion

In view of the foregoing, it is respectfully submitted that all of pending claims 15 to 19 and 21 to 29 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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